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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/445,135

Filing Date: March 13, 2000

Appellant(s): RANDALL ET AL.

MAILED

MAY 3 1 2005

Technology Center 2600

Brian J. Cromarty
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04 April 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct regarding the grounds of rejection to be reviewed.

(7) *Grouping of Claims*

The appellant's brief does not include a statement that the grouping of claims does not stand or fall together and reasons in support thereof. However, such is no longer applicable pursuant to the amended Rules of Practice before the Board of Patent Appeals and Interferences (August 12, 2004).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

WO 96/17473	YOUMAN et al.	6-1996
5,410,692	TORRES	4-1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 40 November 2004.

(11) *Response to Argument*

Appellants' Appeal brief generally sets forth a number of arguments for which the examiner has organized into three general categories. In particular, the appellant argues that the Youman et al. (hereafter Youman) reference fails to teach or suggest the particular limitation of performing an alphabetical sort of the programs based on any criteria, that the examiner has engaged in improper hindsight when concluding that the particular modification of Youman with Torres to arrive at the claimed invention, and that the Torres reference is non-analogous art. As presented/argued, appellant's arguments pursuant to claims 1-5 in the Appeal Brief are equally applicable to claims 6-11 and 12-13 and are not being individually addressed in the Examiner's Answer. The examiner respectfully disagrees with the appellants' arguments for the reasoning set forth and is of the opinion that the rejection should be sustained.

Arguments regarding Youman failing to teach or suggest all the claimed limitations

With respect to appellants' arguments that Youman fails to teach or suggest "an alphabetical sort of the program in response to the user selection of the program descriptive field and an entered text string", the examiner respectfully disagrees. As described by appellants, the Youman reference discloses a user selecting a program descriptive field (ex. Title) whereupon the system displays a subset of the program titles alphabetically by title. As set forth in the grounds of rejection, the user enters a text string whereupon the displayed list is resorted alphabetically so as to display titles beginning with the entered string. For example, as illustrated in Figure 38C, the user is presented with a list of program descriptive fields and designates a program descriptive field or Title, Title – Movie, Title – Sports, Title – Children whereupon the user is presented with a list of titles matching the designated criteria. As shown in Figure 38D, the user designates a character and the display presents an alphabetically sorted list of Titles starting with the letter "A". Accordingly, the system clearly presents an "alphabetical sort of the program in response to the user selection of the program descriptive field" (Title) and an "entered text string" ("A"). As illustrated in Figure 38E, the list comprises a new alphabetically sorted list based upon the closest matching titles starting with the letters "M-A-D". If no sorting is being performed, as argued, then why are the illustrated lists of programs always shown as being presented as a newly sorted alphabetical list in response to the user entered search string? Clearly there are no gaps in the displayed listings associated with removed items and the displayed items are not being displayed in a non-alphabetic fashion, nor does the reference suggest that they are presented in any manner other than alphabetically based upon the user entered search string. It is the examiner's

opinion that one of ordinary skill in the art would therefore conclude that the system always sorts/resorts the remaining subset alphabetically for display as illustrated in the reference.

Appellants' arguments appear to be premised on the fact that the Youman reference does not teach or suggest performing an alphabetical sort of the programs based on any criteria including criteria other than "Title". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., any criteria) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Youman discloses sorting alphabetically based on title and the user entered search string. The specification discloses the ability to perform alphabetic sorting based on predefined criteria including title, star, director, or context of the program and further set forth that a limitation of prior art searching is that it does not allow a user to sort other categories or information related to the program (IA: Page 3, Lines 18-23). However, the present claims simply do not require such flexibility in sorting. Both the claims and the specification set forth that a single criteria including "Title" may be designated and that the system subsequently performs a sort based upon "Title" and a user entered text string. The appellant, however, has not chosen to limit the claim to a particular descriptive field other than "Title" consistent with what is disclosed as the inventive concept (IA: Page 3, Lines 26-31). Accordingly, it is the examiner's opinion that the claimed limitation of performing "an alphabetical sort of the program in response to the user selection of the program descriptive field and an entered text string" is met by Youman.

Arguments regarding improper hindsight to modify Youman with Torres

With respect to appellants' arguments that the examiner has engaged in improper hindsight so as to modify the illustrated graphical representation of the Youman with the graphical interface of Torres so as to "display concurrently a list of program descriptive fields" and "an entry for entering a text string", the examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As set forth in the grounds of rejection, the examiner concedes that the Youman reference does not explicitly illustrate a combined screen comprising the elements of Figures 38C and 38D. However, the examiner has provided evidence that the particular limitation in conjunction with searching for programs of interest within an electronic program guide was within the level of ordinary skill (see Final rejection, mailed 22 April 2004 - Page 4, Lines 17-22) and has set forth an objective basis and motivation by which one would make an aesthetic design modification to equivalently display elements from two separately illustrated screens onto one screen. The Torres reference provides evidence that it was not only known in the art so as to provide an entry for entering a text string and a list of descriptive fields, but also provides an explicit motivation for employing such an interface in order to support dynamic search functionality.

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has modified the aesthetics of the graphical interface utilized to search a database of television programs of Youman with teachings of Torres as to the desirability of providing a graphical user interface for searching databases that facilitates dynamic searching. Youman provides no explicit teachings so as to particularly dissuade one from not modifying the exemplary interface presentation. Nor is it outside the ordinary skill in the art so as to modify the appearance of a user interface. As aforementioned, Figure 3 of the Torres reference provides further evidence that it is known in connection with searching a database for items of interest to display an entry for entering a text string, a list of descriptive fields, and the search results within a single screen in conjunction with database search operations. Furthermore, Torres sets forth that it is advantageous so as to provide such an interface in connection with dynamically accelerating the refinement of search arguments during the course of a search (Torres: Col 7, Lines 33-39; Col 1, Lines 9-22; Col 2, Lines 3-31). The Youman reference does not allow for a dynamic search in so far as if a user would like to change program descriptive fields (ex. Title – All versus Title – Movie) the user would have to switch screens and start the search all over. Torres teaches that having to start searches over when the user fails to find what

they are looking for is both frustrating and an inefficient use of time. Accordingly, it is the examiner's opinion that the suggestion so as to modify the Youman reference so as to incorporate all of the search elements (ex. list of program descriptive fields, text string entry, and results) in a single screen so as to facilitate dynamic search refinement as taught by Torres.

Arguments regarding Torres not being analogous art

In response to appellants' argument that the Torres is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is the examiner's opinion that the reference is both in the same field of endeavor and reasonably pertinent to the particular problem with which the inventor is involved.

Appellants argue that the Torres reference discloses a computer database system comprising a computer and software and that "one of ordinary skill in the art" being a user interface designer would not look to the computer program field to find a solution for a program guide. The examiner respectfully disagrees that one of ordinary skill in the art such as an interface designer would not look to the computer program field to find a solution for a program guide (though it is unclear as to why appellants have deemed that only an interface designer is considered as one of ordinary skill in the art in the present case). The applied Youman reference discloses a method for presenting an electronic program guide on a

personal computer (Col 7, Lines 41-49). Accordingly, it would seem reasonable if one was to modify the user interface of a program guide being displayed on a computer that one would look to a computer field for interface designs. The specification of the instant application further sets forth that the system as described is exemplary may take the form of other digital signal processing devices including a PC-TV (IA: Page 11, Lines 12-27). A PC-TV is a type of computer and an EPG, as used herein, is a computer program or application which generates a particular graphical display. The Torres reference similarly provides a user interface for a computer. Therefore, it is the examiner's opinion that appellants' invention is in the same field of endeavor namely graphical user interfaces for digital signal processing devices which facilitate retrieval of information from a database. As set forth by the appellant, both the Youman and Torres references are directed towards finding information in a database. Both references utilize graphical interfaces so as to facilitate the finding of this information and both references are forms of computers or digital signal processing devices. Similarly, the instant application, as argued, is directed towards the interface design of a computer which retrieves information from a database. Accordingly, it is the examiner's opinion that the Torres reference is from the same field of endeavor as the instant application.

As to appellants' arguments that the system of Torres would be impossible to navigate using a standard program guide user interface such as a remote control, it is unclear as to why such is relevant to whether or not the Torres reference is analogous art. However, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) with respect to the inoperability of the prior art.

Accordingly, such arguments are considered moot as applicant has failed to provide any objective evidence showing why it would be impossible to particularly navigate through an computer graphical interface using a remote control. However, should the Board feel it necessary to provide evidence refuting the assertion that it is “impossible” to operate a computer interface with a remote control, it is noted that the Schein et al. (US Pat No. 6,133,909) reference of record (Col 13, Lines 21-25) discloses a remote control that serves as a keyboard in order to facilitate the user’s interaction with the graphical display or EPG displayed on a computer or PC-TV.

With respect to appellants’ arguments that the art disclosed in Torres is not reasonably pertinent to the problem the present application addresses namely the difficulty in locating a desirable program in a fixed guide format (IA: Page 3, Lines 11-16). It is unclear that appellants’ cited passage is actually the problem being solved by the instant application as opposed to the characterization of the prior art as not providing the ability to customize the program guide listings. Customizing the display of a program guide (ex. fonts, colors, etc.) and actively performing flexible searches in conjunction with alphabetic sorting so as to locate programs of interest are not the same. Rather, the problem to be solved appears to be in providing the user with a flexible program searching capability (IA: Page 3, Lines 17-31) which is provided by Torres. Appellants have apparently shifted positions as to the problem being solved by the invention during prosecution. In particular, appellants have previously argued (response to Non-Final Rejection – 14 April 2004) that the particular problem that the instant application is directed to was to facilitate the ability of the user to easily modify search criteria based on the search results and quickly make multiple searches. The examiner

believes that the Torres reference is reasonably pertinent to this problem of providing flexible searching capabilities given that the reference teaches that the user may easily modify search criteria in order to conduct multiple searches. Furthermore, given that the Torres reference provides a particular search interface for easily finding information of interest in a database such appears to be reasonably pertinent to the newly set forth problem of pertaining to the difficulty of locating a desirable program given that a "program" as set forth in the specification is not limited to broadcast television (IA: Page 11, Lines 23-27).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

SEB
May 16, 2005

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